

REMARKS

Reconsideration of the rejections is respectfully requested. Claims 1 to 16 and 22 are currently pending.

The Office Action mailed October 26, 2001 addressed Claims 1 to 22. Claims 1 to 16 and 22 were rejected. Claims 17 to 21 were withdrawn. Applicants note with appreciation the withdrawal of the rejection under 35 U.S.C. 112, second paragraph.

The Examiner stated that Applicant has not provided a priority date for the publications: "Manual for the Rubber Industry" and "UREPAN-Specialty Elastomers with a Wide Range of Applications for the Rubber Industry". Enclosed is a copy of the cover and copyright pages of "Manual for the Rubber Industry" showing that the copy deadline was July 1, 1993. Applicants are continuing to attempt to determine a priority date for the "UREPAN" publication. Enclosed is a copy of a Technical Data Sheet for Urepant[®] 50 EL 06 G showing a date of March 18, 1996.

Claims 1 to 8, 10 to 14, 16 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of "Manual for the Rubber Industry". The Examiner stated that Walker et al. disclose a basketball construction including a bladder (12), a layer of filaments (16) wound over the bladder and a cover (34) of polyurethane for the ball, but Walker et al. lack the teaching for the cover to be formed from vulcanized urethane gum rubber. The Examiner further stated that the "Manual for the Rubber Industry" reveals the manufacturing process for vulcanized urethane gum rubber and notes its advantages, such as "particularly good mechanical properties" and that "wear resistance under many service conditions is better than that of other elastic material". The Examiner concludes that it would have been obvious for one of ordinary skill in the art to replace the polyurethane of Walker et al. with that taught by the "Manual for the Rubber Industry" in order to provide an improved polyurethane with better mechanical properties and wear resistance.

Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness. Applicants respectfully submit that contrary to the Examiner's assertions, there is no motivation or teaching to form the cover of Walker et al. from

vulcanized urethane gum rubber. Walker et al. disclose a basketball with a synthetic cover, specifically a basketball having a cover comprising a plurality of polyurethane inserts formed with matted fibers of nylon or a polyester with a diameter of about 1 micron (see Abstract, column 2 lines 46 to 53, and claims 1 and 2). The purpose of Walker et al. is to provide an improved synthetic basketball with superior characteristics like real leather covered balls (see columns 1 and 2), not to provide improved rubber covered balls with better mechanical properties and wear resistance. Walker et al. do not disclose a basketball having a rubber cover, more specifically a urethane gum rubber cover. The polyurethane used in the cover of Walker et al. is used to impregnate fibers and to simulate leather, thus providing a softer feel on the cover at a reduced cost as compared to high grade leathers (see column 5, line 15 to column 6, line 31).

Applicants' invention is not directed to a synthetic leather covered game ball. The cover of Applicants' game ball comprises a layer of vulcanized urethane gum rubber. Applicants respectfully submit that the Examiner has used impermissible hindsight to reconstruct Applicants' invention, and it is impermissible to pick and choose from one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what the reference fairly suggests to one skilled in the art. A prior patent, such as Walker et al., must be considered as a whole. Applicants respectfully submit that Walker et al. is directed to balls having higher quality synthetic covers similar to high grade leather covers, and Walker et al. has no reason to substitute an inferior cover of rubber. Therefore, there is no motivation or teaching to combine Walker et al. with "Manual for the Rubber Industry" since Walker et al. is directed to the use of synthetic panels on a basketball to make the cover feel more like leather, and "Manual for the Rubber Industry" discusses vulcanized urethane gum rubbers and their improved properties. When the prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself. Something in the prior art as a whole must subject the desirability of making the combination. Applicants respectfully submit that the Examiner has failed to

show the desire, or motivation, to combine Walker et al. with "Manual for the Rubber Industry." Walker et al. is not using a urethane rubber, or any type of rubber, as the panels of the basketball, nor would Walker et al. have any reason to use vulcanized urethane gum rubber on the game ball since Walker et al. is directed to synthetic leather balls.

The Examiner stated that regarding claims 2 to 6 and 10, "Manual for the Rubber Industry" teaches the crosslinking of the urethane with sulfur and the use of the other materials for forming the polyurethane. As previously stated, there is no motivation or teaching to combine Walker et al. and "Manual for the Rubber Industry" since Walker et al. is directed to improving synthetic covered basketballs to provide a better leather-like feel, not improving rubber covered balls. There is no motivation for Walker et al. to substitute a rubber cover on their game ball, which comprises an improved synthetic covered ball with the feel and handling of leather.

The Examiner stated that regarding claims 7 and 8, Walker et al. teach the use of a rubber carcass (20) as an inner layer. As previously stated, Walker et al. is directed to basketballs with synthetic leather covers with a softer feel, not to urethane gum rubber covers. Therefore, the addition of the rubber carcass as an inner layer with a synthetic cover does not produce the game ball of Applicants' invention because Applicants' invention requires a urethane gum rubber cover, and, as previously stated, there is no motivation for Walker et al. to substitute a rubber cover on their game ball, which comprises an improved synthetic leather cover.

For at least these reasons, Applicants respectfully submit that claims 1 to 8, 10 to 14, 16 and 22 are not obvious under 35 U.S.C. § 103(a) over Walker et al. in view of the "Manual for the Rubber Industry". Applicants therefore respectfully request that the rejection of claims 1 to 8, 10 to 14, 16 and 22 under 35 U.S.C. § 103(a) as obvious over Walker et al. in view of the "Manual for the Rubber Industry" be reconsidered and withdrawn.

Claims 9 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of "Manual for the Rubber Industry" and Schindler et al. The Examiner stated that the combination of Walker et al. in view of "Manual for the

"Rubber Industry" lacks the teaching for the inner layer to be foamed. The Examiner further stated that Schindler et al. reveal a basketball construction including a bladder (12), a layer of windings (14), an inner layer (16) of foamed rubber and a cover (18). The Examiner concluded that it would have been obvious to one of ordinary skill in the art to replace the inner layer of Walker et al. with that of Schindler et al. for the reasons advanced by Schindler et al.

Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness. As previously discussed, Walker et al. disclose a basketball with a synthetic cover with superior characteristics like real leather covered balls (see columns 1 and 2). Walker et al. do not disclose a basketball having a rubber cover, more specifically a urethane gum rubber cover.

Applicants' invention is not directed to a synthetic leather covered game ball. The cover of Applicants' game ball comprises a layer of vulcanized urethane gum rubber. As discussed above, there is no motivation for the combination of Walker et al. and "Manual for the Rubber Industry" to produce Applicants' invention. Therefore, the addition of another secondary reference, Schindler et al., does not remedy this defect. In addition, Applicants respectfully submit that the Examiner has used impermissible hindsight to reconstruct Applicants' invention, and it is impermissible to pick and choose from one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what the reference fairly suggests to one skilled in the art. A prior patent, such as Walker et al., must be considered as a whole. Applicants respectfully submit that Walker et al. is directed to balls having higher quality synthetic covers similar to high grade leather covers. Therefore, there is no motivation or teaching to combine Walker et al. with "Manual for the Rubber Industry" and Schindler et al. When the prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself. Something in the prior art as a whole must subject the desirability of making the combination. Applicants respectfully submit that the Examiner has failed to show the

desire, or motivation, to combine Walker et al. with "Manual for the Rubber Industry" and Schindler et al.

For at least these reasons, Applicants respectfully submit that claims 9 and 15 are not obvious under 35 U.S.C. § 103(a) over Walker et al. in view of the "Manual for the Rubber Industry" and Schindler et al. Applicants therefore respectfully request that the rejection of claims 9 and 15 under 35 U.S.C. § 103(a) as obvious over Walker et al. in view of the "Manual for the Rubber Industry" and Schindler et al. be reconsidered and withdrawn.

Claims 1 to 16 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Molitor et al. in view of "Manual for the Rubber Industry". The Examiner stated that Molitor et al. disclose an inflated game ball comprising a cover (12), an inner carcass (11) and a sponge layer (15), and notes column 2, lines 31 and 32 of Molitor et al. which teach that the cover may be formed from rubber. The Examiner further stated that it would have been obvious to one of ordinary skill in the art to form the cover of Molitor et al. from the material of the "Manual for the Rubber Industry" in order to take advantage of that material's physical characteristics. The Examiner concluded that regarding claims 9 and 15, Molitor et al. teach the use of a sponge layer.

Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness. Molitor et al. disclose a ball with a sponge layer between the inner carcass and the outer cover, and this sponge layer provides sufficient yielding of the outer surface of the ball to enhance handling when gripped (column 1, lines 27 to 31). Molitor et al. disclose that the cover can be any material known at the time, such as rubber, leather or any other well known material (column 2, lines 31 to 33). Molitor et al. does not disclose specific types of cover materials at all as the invention is concerned with the sponge layer of the ball.

Applicants' invention is not directed to a ball with a sponge layer between the inner carcass and the outer cover such that the sponge provides enhanced gripping of the ball. The cover of Applicants' game ball comprises a layer of vulcanized urethane gum rubber to improve durability and abrasion resistance. Once again, Applicants

respectfully submit that the Examiner has used impermissible hindsight to reconstruct Applicants' invention, and it is impermissible to pick and choose from one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what the reference fairly suggests to one skilled in the art. A prior patent, such as Molitor et al., must be considered as a whole.

Applicants respectfully submit that Molitor et al. is directed to balls having enhanced gripping capability due to a sponge layer between the carcass and the cover, and a person of ordinary skill in the art would have no guidance from Molitor et al. regarding a particular cover material since Molitor et al. does not disclose or appreciate the benefits of urethane gum rubber, particularly a cover having improved durability and abrasion resistance such as Applicants, except for the guidance supplied by the Examiner in making the rejection. Therefore, Applicants respectfully submit that there is no motivation or teaching to combine Molitor et al. with "Manual for the Rubber Industry". When the prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself. Something in the prior art as a whole must subject the desirability of making the combination. Applicants respectfully submit that the Examiner has failed to show the desire, or motivation, to combine Molitor et al. with "Manual for the Rubber Industry".

For at least these reasons, Applicants respectfully submit that claims 1 to 16 and 22 are not obvious under 35 U.S.C. § 103(a) over Molitor et al. in view of the "Manual for the Rubber Industry". Applicants therefore respectfully request that the rejection of claims 1 to 16 and 22 under 35 U.S.C. § 103(a) as obvious over Molitor et al. in view of the "Manual for the Rubber Industry" be reconsidered and withdrawn.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

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CONCLUSION

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 1 to 16 and 22. Applicants respectfully request allowance of claims 1 to 16 and 22, the claims currently pending.

Respectfully submitted,

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